

REMARKS

In response to the Office Action mailed August 28, 2003, Applicants affirm the provisional election made without traverse to prosecute the invention of Group I (claims 1-17, 37-38, and 41). In the Office Action, claims 1-17, 37-38, and 41 are rejected under 35 USC §102(e) as being anticipated by Bull et al. (US Patent 6,498,841, hereinafter "Bull"). Claims 6-8, 11-13, and 15-17 are rejected under 35 USC §103(a) as being unpatentable over a combination of Bull and Mitome (US Patent 5,204,905) or Acero et al. (US Patent 6,163,769, hereinafter "Acero").

In response to the claims 1-17, 37-38, and 41 as being anticipated by Bull, Applicants have amended the claims to more clearly define Applicants' invention. In particular, Applicants have amended dependent claims 1, 37, 38 and 41 to recite steps of or means for:

placing the first telephone subscriber unit on hold responsive to the step of
determining; and
sending a ringing signal to the first telephone subscriber unit over the first
communication channel responsive to the step of placing;

Applicants note that independent claims 9 and 14 as pending include similar limitations.

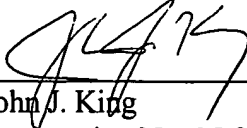
In contrast to Applicants' invention, Bull discloses a communication system which places an existing call on hold. The system 100 of Bull enables a customer at the called communication station 104 to be efficiently and effectively notified that a current call from calling communication station 106 is waiting. The system 100 provides audible notification for all incoming calls, whether the call is a current call or a call waiting call which is received while the current call is still in progress. The system 100 also provides an enhanced call message that includes both the call waiting indicator and the audible representation of information associated with the calling communication station 106. The audible representation could be produced from stored standard caller ID with caller name information. The caller name is processed through a text to speech facility to produce the audible representation. If the standard caller identification information can not be provided, the calling party is prompted by the system to state his name as spoken caller identification information. The spoken caller identification information is then

provided as the audible caller identification information. The audible caller identification information associated with the calling communication station alerts the customer that the current call is present or waiting and provides the customer with information that assists the customer in deciding whether to take the current call.

However, Bull fails to disclose or suggest placing a first subscriber unit (i.e. a subscriber unit making a call) being put on hold. The Examiner suggests that Bull discloses putting an existing call on hold, as described in reference to Fig. 5, discloses placing a first subscriber unit on hold. However, Applicants claim receiving a telephone call from the first telephone subscriber unit to the telephone network over a first communication channel responsive to the first telephone subscriber unit originating the telephone call to the second telephone subscriber unit through the telephone network and determining that the second party subscribes to a speech-based caller identification service provided by the telephone network responsive to the step of receiving the telephone call. Applicants then place the first telephone subscriber unit on hold responsive to the step of determining, and send a ringing signal to the first telephone subscriber unit over the first communication channel. Accordingly, Applicants submit that the claims as amended are allowable over the cited references.

In response to the rejection of Claims 6-8, 11-13, and 15-17 as being unpatentable over Bull and Mitome or Acero, Applicants respectfully submit that the rejection is improper. Under 35 USC §103(c), subject matter developed by another person which qualifies under 35 USC §102(e) shall not preclude patentability under 35 USC §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person. Bull et al. (US Patent 6,498,841) and the present application are both owned by Ameritech Corporation. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Applicants submit that the dependent claims are allowable for the same reasons that the independent claims are believed allowable. Applicants respectfully request reconsideration of the claims as amended. Respectfully submitted,



John J. King
Registration No. 35,918
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200